

### REMARKS

Upon entry of the proposed amendments, claims 1, 2, 5-7, 10, 11, 21 and 23 will be pending. Claims 10 and 11 have been withdrawn. Claims 3, 4, 8, 9, 12-20, and 22 have been canceled. Applicants have amended claims 1, 2, 7, 10, 21 and 23. Although the proposed amendments would add some new terms, they would raise no new issues that would require further consideration and/or search. The amendments are supported throughout the application, for example, at page 33, line 13 to page 34, line 13; and page 6, lines 1-6 (see the amendment to the specification set forth in the Preliminary Amendment filed on November 12, 2004). Applicants submit that these amendments would place the claims into condition for allowance, or at least present the rejected claims in better form for consideration on appeal, and should therefore be entered after the final rejection under 37 C.F.R. § 1.116. No new matter has been added.

#### Information Disclosure Statement

Applicants thank the Office for considering the reference cited in the Information Disclosure Statement submitted on October 15, 2007.

#### Withdrawn objections and rejections

Applicants note with appreciation that the Office has withdrawn the objections to the specification and the rejection of claims 1, 2 and 7 under 35 U.S.C. § 102(b).

#### 35 U.S.C. § 112, First Paragraph (enablement)

The Office rejected claims 1, 2, 5-7, 21 and 23 as allegedly lacking enablement. According to the Office Action (at pages 3-4): "... whatever constitutes a D4Z4 is highly polymorphic and varies with individual and with species and thus lacks any structure or structural boundaries ... What constitutes a D4Z4 binding element or a 4q35 D4Z4 binding element appears to the Examiner to be the remaining issue. Also, the number of repeats remain open such that an infinite number of undescribed repeats are encompassed. "

As applicants understand it, the Office is of the view that the claims would not meet the enablement requirement unless they recite specific SEQ ID NOs. Applicants do not agree with this rejection. However, for the sole purpose of expediting prosecution of this application, applicants have amended claims 1, 2, 7, 21 and 23 to recite a D4Z4 binding element that comprises at least one nucleic acid sequence of SEQ ID NO: 21 or at least one of nucleic acid sequence of SEQ ID NO: 23. Accordingly, applicants submit that the claims are enabled, and respectfully request reconsideration and withdrawal of this rejection.

35 U.S.C. § 112, First Paragraph (written description)

The Office rejected claims 1, 2, 5-7, 21 and 23 as allegedly failing to comply with the written description requirement. The Office Action states (at page 4): "... one of skill in the art would not recognize a 4q35 d4z4 repeat since d4z4 repeats are highly polymorphic and variable and vary between individuals as well as species as argued in the prior action of 3/22/07. Furthermore, as written the claims encompass an infinite number of DNA repeats, whatever they might be."

As applicants understand it, the Office is of the view that the claims would lack written description unless they recite specific SEQ ID NOs. Applicants respectfully disagree with this rejection, but have amended claims 1, 2, 7, 21 and 23 as noted above for the sole purpose of expediting prosecution of this application. The claims now recite a D4Z4 binding element comprising a specific nucleic acid sequence, such that skilled practitioners would readily recognize that applicants had possession of the claimed method. Applicants submit that the claims are adequately described. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance, which expeditious action is requested. Applicants do not concede any positions of the Examiner that are not expressly addressed above, nor do applicants concede that there are not other good reasons for patentability of the presented claims or other claims. All amendments and

withdrawals are made without prejudice and disclaimer and may be made for reasons not explicitly stated or for reasons in addition to ones stated.

The fees in the amount of \$230 for the petition for extension of time are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney's Docket No. 07917-180001.

Respectfully submitted,

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